

REMARKS

This Amendment and Response is submitted in response to the Office Action mailed 31 OCTOBER 2003. Withdrawal of the rejection and reconsideration with an eye toward allowance is respectfully requested.

Claim Status

Claims 1, 3, 4, 9-11, 13, 14, 21-27, and 29-37 are pending after entry of the present amendment. Claims 1, 3, 4, 9-11, 13, 14, 21-27, and 29-31 stand rejected. Claims 1 and 29 are amended herein for technical clarity, and claims 32-37 are added. A complete listing of all claims that are, or were in the application, along with an appropriate status identifier, is provided above in the section entitled "Amendments to the Claims". Markings are provided on claims amended in the present amendment.

Support for the above claim amendments can be found throughout the originally filed specification, drawings, and claims, for example in Fig. 6.

Claim Rejections – 35 U.S.C. §103

Claims 1, 3, 4, 9-11, 23, and 27 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tognazzini (5,739,512) in view of Kapp (5,195,133). Applicant submits that the cited references, taken alone or in combination, fail to disclose or suggest "providing upon request retrieval of an electronically generated user-viewable image of said first and second electronically captured signatures".

Tognazzini is directed toward digital delivery of receipts (see abstract). Tognazzini discloses that a digital receipt may be optionally encrypted and then delivered to a traveler's electronic address as e-mail for later retrieval (see col. 6, lines 33-39).

Kapp is directed toward a method and system for generating a completed payment document ready for signature in image form. (See abstract). Kapp discloses means for capturing a customer signature by means of a stylus-activated mechanism and integrating the signature into the document image. The resulting image may then be printed to provide a hard copy document for customer records, and may be stored and transmitted in electronic form to provide an electronic image for records maintained and used by the merchant and/or financial institution. (Kapp, col. 1, lines 55-66)

Applicant submits, as stated above, the references, taken alone or in combination, fail to disclose or suggest, "providing upon request retrieval of an electronically generated user-viewable image of said first and second electronically captured signatures". Tognazzini is limited to disclosure of e-mailing electronic receipts to a user after a transaction has occurred. Tognazzini does not disclose retrieving a user-viewable image of two electronically-captured signatures obtained during different transactions. Kapp is limited to disclosure of capturing a signature and transmitting a record to a merchant or financial institution. Kapp does not disclose, teach, or suggest retrieving user-viewable images of electronically captured signatures from two transactions, as recited by Applicant's independent claim 1.

Claims 3, 4, 9-11, 23, and 27 depend from and include all limitations of Applicant's independent claim 1 and are accordingly patentable over Tognazzini and Kapp for at least the reasons described above with regard to claim 1.

Claims 1, 3, 4, 9-11, 22-27 and 29-31 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tognazzini (5,739,512) in view of Francini et. al. (EP 0 474 360). Applicant respectfully submits that there is no suitable motivation to combine the references. Applicant further submits that the references, taken alone or in combination fail to disclose or suggest "providing upon request retrieval of an electronically generated user-viewable image of said first and second electronically captured signatures", as recited in Applicant's independent claim 1, or "retrieving a copy of the first and second electronic records including of an electronically generated user-viewable image of said electronically captured signature from the electronic-record repository over an internet, said copy including a user-viewable image of said electronically captured signature," as recited in Applicant's independent claim 29.

Tognazzini is discussed above.

Francini is directed toward validating the authenticity of a transaction employing electronic receipts (see abstract). Francini discloses that, in the event the customer questions a transaction, the financial institution associated with a merchant can generate a hard copy receipt (see abstract).

Applicant submits that there is not a suggestion or motivation to combine the teaching of Tognazzini with that of Francini. The Examiner suggests the motivation would have been to validate and approve the transaction (see office action, page 5). As described above, Tognazzini discloses that a digital receipt may be optionally encrypted and then delivered to a traveler's electronic address as e-mail for later retrieval (see col. 6, lines 33-39). Applicant submits that there is no motivation for combining the system disclosed by Tognazzini to e-mail electronic receipts to a traveler with the system described by Francini for allowing an institution to generate a hard copy receipt in the event a consumer questions a transaction. "The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination." In re Bergel, 130 USPQ 206, 208 (CCPA 1961). Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection is improper, and should be withdrawn.

Further, Applicant submits that Tognazzini, as stated above, is limited to disclosure of e-mailing electronic receipts to a user after a transaction has occurred. Tognazzini does not disclose retrieving records, or digital signature images, obtained from separate transactions, as recited in Applicant's independent claims. Francini is limited to disclosure of providing a hard copy receipt in the event a customer questions a transaction. Francini does not disclose or suggest retrieving an electronically generated user-viewable image of signatures. Accordingly, Applicant submits that independent claims 1 and 29 are patentable over Tognazzini and Francini.

Claims 3, 4, 9-11, 22-27 depend from and include all limitations of Applicant's independent claim

1. Claims 30-31 depend from and include all limitations of Applicant's independent claim 29.

Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection of claims 1, 3, 4, 9-11, 22-27, and 19-31 is improper, and should be withdrawn.

Claims 13, 14, and 21 were rejected under 35 U.S.C. §103(a) as being unpatentable over Tognazzini in view of Francini in further view of Kobayashi (5,864,825). Applicant respectfully submits that suitable motivation to combine the references is lacking. Applicant further submits that the references, taken alone or in combination, fail to disclose or suggest "providing upon request retrieval of an electronically generated user-viewable image of said first and second electronically captured signatures", as recited in Applicant's independent claim 1.

Tognazzini and Francini are discussed above.

Kobayashi is directed toward classifying and totaling the past purchase data of the customers stored in a point-of-sales data management system (see Abstract).

As discussed above, Applicant submits that there is not motivation to combine the teachings to Tognazzini and Francini. Applicant further submits that there is not proper motivation to combine the teachings of Kobayashi with those of Tognazzini or Francini. The Examiner suggests that the motivation would be to provide a transcript of a purchase receipt when the purchase receipt was missing (see office action, page 6). Tognazzini is concerned with e-mailing electronic receipts to a traveler while Francini is concerned with generating a hard copy receipt in the event a user questions a transaction. There is no motivation to combine those teachings with that of Kobayashi that concerns the totaling of past purchase data of customers stored in a point-of-sales data management system. "The mere fact that it is possible to find two isolated disclosures which might be combined in such a way to produce a new compound does not necessarily render such production obvious unless the art also contains something to suggest the desirability of the proposed combination." In re Bergel, 130 USPQ 206, 208 (CCPA 1961).

Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection is improper, and should be withdrawn.

Applicant submits that the references, taken alone or in combination, fail to disclose, teach or suggest "providing upon request retrieval of an electronically generated user-viewable image of said first and second electronically captured signatures", as recited in Applicant's independent claim 1. That neither Tognazzini or Francini discloses these features is discussed above. Applicant submits that Kobayashi further fails to disclose this feature, as Kobayashi is limited to disclosure of totaling past purchase data of the customers stored in a point-of-sale system. Claims 13, 14, and 21 depend from and include all limitations of Applicant's independent claim 1. Accordingly, Applicant submits that the 35 U.S.C. §103(a) rejection of claims 13, 14, and 21 over Tognazzini in view of Francini in further view of Kobayashi is improper and should be withdrawn.

New Claims

Serial No.: 09/480,883
Filing Date: 10 JANUARY 2000

Applicant has added new claims 32-37 that further distinguish over the cited art. For example, claim 32 recites first and second transactions, claim 33 recites a system, and claim 34 recites a computer program product. Claims 35-37 specify differences in a first and second transaction. The new claims may also be distinguished over the cited art in other ways.

CONCLUSION

Applicants submit the claims are in condition for allowance, and notification of such is respectfully requested. If after review, the Examiner feels there are further unresolved issues; the Examiner is invited to call the undersigned at (415) 781-1989.

Respectfully submitted,
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Filed under 37 C.F.R. §1.34(a)

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